

Applicant : Dennis G. PRIDDY
Appl. No. : 09/420,459
Examiner : Luong T. Nguyen
Docket No. : 11104.2

REMARKS

In an effort to more clearly and completely describe the present invention, Applicant has had reviewed the pending claims and made a number of amendments. Claim 1 has been amended to correct an inadvertent typographic error. Claim 2 has been amended in response to the Examiner's rejection under §112. Claims 5, 9, 14, 15, 23, 25 and 27 have been amended as suggested by the Examiner. Claims 5, 9-13, 24 and 27-29 have been amended to define more clearly the subject matter which Applicant regards as his invention. Claims 26 and 29 have been amended to correspond to their respective base claims. New claims 30-36, directed to a communications node have been added to claim the invention more completely. New claim 37 is directed to a limitation previously in, and now canceled from, claim 5. Claims 37 and 38 are directed to a semiconductor device. Claims 17-22 are cancelled without prejudice to their being filed in a divisional application claiming priority herefrom.

The Examiner's allowance of claims 1, 3-8, 14, 23-24, and 26-29 and indication that claim 2 contains allowable subject matter are noted with appreciation.

Reconsideration is respectfully requested in light of the foregoing amendments and the following.

Claim Rejections

(i) Rejections Based On Glass

(a) § 102 Rejections Based On Glass

Claim 9

Claims 9-12 and 25 were rejected under 35 U.S.C. § 102 as being anticipated by U.S. Patent No. 6,332,193 to Glass ("Glass"). We respectfully traverse.

Glass discloses a communications node that receives a message sent by a host desktop

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computer incorporating a cropped and compressed digital image that is combined with a secret key, (optionally) a digital token, and a digital signature. The communications node (i.e., the authentication server) validates that the message has not been altered during transmission by computing the same or complementary digital signature algorithm on the transmitted digital image data, using its knowledge of the token or complementary token respectively, along with the server's copy of the secret key.

Glass, however, does not disclose or suggest the use of data element identifiers; nor are data element identifiers required to be used in the closed-system architecture described by Glass. Further, the transmission received by the Glass authentication server contains a token and a cropped or compressed picture image – not a biometric automatic identification indicia, and not personal financial data separated by data element identifiers, as required by claim 9 as amended.

Furthermore, Glass does not teach or suggest a communications node that receives a transmission from a user that already is remotely authorized. Rather, Glass teaches away from what is called by in claim 9 in teaching to calculate a template from the degraded picture *at* the authentication server (i.e., at the device that the Examiner contends is a communications node, which contention we respectfully disagree with) and compare it to a plurality of templates stored within that authentication server. In contrast, as disclosed in Applicant's specification, the biometric automatic identification indicia is generated from the captured full-resolution image within a multi-function semiconductor device and is compared to the one locally-stored reference biometric automatic identification indicia within the multi-function semiconductor device/portable wireless communications product. If this comparison is valid, the generated biometric automatic identification of indicia of the remotely authenticated user is transmitted and hence received by the communications node, as called for in claim 9 as amended.

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As further concerns the subject matter of claim 9, the communications node does not contain any templates and does not require any indicia to be calculated or generated within the communications node. Thus, claim 9 as amended distinguishes over Glass because user authentication is performed by the portable communications device and not at the communications node or "authentication servers" and the transmission received at the communications node is of a remotely authenticated user.

Accordingly, Applicant's claim 9, as amended, and claims 10-13, 25 and 26 depending therefrom, are believed allowable over the art of record. Glass does not anticipate and withdrawal of the § 102 rejection of claims 9-12, 25 and 26 respectfully is requested.

(b) § 103 Rejection Based On Glass

Claim 13

Claim 13 was rejected under 35 U.S.C. § 103 as being obvious in view of the combination of Glass and Alperovich. This ground of rejection should be withdrawn because Alperovich does not cure the above-noted deficiencies of Glass with respect to the independent claim 9, and thus claim 13 which depends from claim 9 is allowable for at least the same reasons that claim 9 is allowable. Specifically, the § 103 rejection should be withdrawn because the combination of Glass and Alperovich does not disclose or suggest, among other things, a communications node capable of receiving the transmission "from a remotely authenticated user and incorporating data element identifiers separating data elements including biometric automatic identification indicia and personal data associated with a proposed financial transaction" or " means for identifying said remotely authenticated user in response to said received automatic identification indicia to permission executing said proposed financial transaction" as required by claim 9 from which claim 13 depends.

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The Examiner's § 103 rejection based on Glass and Alperovich also should be withdrawn because the Examiner has not made the required specific showing that one of ordinary skill in the art would have been motivated to make the combination of Glass and Alperovich as suggested by the Examiner. Absent this showing, the § 103 rejection is improper. *See In re Rouffet*, 149 F.3d 1350, 1359 (Fed. Cir. 1998) ("even where the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill would have been motivated to select the references and to combine them to render the claimed invention obvious."). We respectfully submit that, notwithstanding the Examiner's reliance on *In re McLaughlin*, 443 F.2d 1392 (CCPA 1971), the Examiner's position that "applying the teaching of Alperovich to the device of Glass allows a user to view a scene at a remote location" (Action, page 10) fails to identify the predicate motivation to apply the teaching of Alperovich to Glass in the first instance. We further respectfully submit that this is because there is no motivation to make the combination. Alperovich is directed to reducing the transmission load created by digital images (Alperovich, Col. 3, lines 23-29) whereas Glass is directed to secure transmission of biometric data to a remote location (Glass, Col. 3 at lines 30-42). Absent a motivation, and the Examiner has provided none, there is no basis to apply Alperovich to Glass - except impermissible hindsight, and thus the rejection of claim 13 should be withdrawn.

(ii) Rejections Based On Hsu

In the Action, the Examiner rejected claims 15 and 16 under 35 U.S.C. § 102(e) based on Hsu (EP 0924657). We respectfully traverse.

Hsu refers to a closed system designed for the singular purpose of verifying the identity of a person seeking access to a remote protected property, where the person seeking access to the

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remote property has been pre-registered with that remote property based on a code word generated from a biometric attribute. Hsu discloses at column 5, lines 48-50, "A person seeking entry to the door 10 carries a small handheld device, which may be integrated into a cellular telephone...." The single integrated circuit of the present invention as defined in claim 15 is not, in and of itself, a "small handheld device," but rather is a unique integrated semiconductor circuit (or chip) that must reside within a separate host handheld device. Significantly, the structure and architecture of the claimed multi-function semiconductor circuit is not inherently included in a cellular telephone.

In this regard, Hsu Figure 2 discloses device 14 to include "processor module" 20, but Hsu does not teach or suggest that module 20 is a single integrated circuit as called for in claim 15 (as amended). Nor do Figures 2 or 3 of Hsu teach or suggest the presence of a secure personal [financial] information database in a single integrated circuit as required by claim 15. Further, the term "module" as used in Hsu is commonly understood by a person of ordinary skill in the art as: "An independent assembly of electronic components with some distinct function, e.g., a RAM module consisting of several RAM chips mounted on a small circuit board." Therefore, the definition of a module cannot be construed to also encompass a single integrated semiconductor chip of Applicant's invention as called for in Claim 15, and Claim 16 depending therefrom.

For all of the foregoing reasons, withdrawal of the § 102(e) rejection of claims 15 and 16 based on Hsu is respectfully is requested.

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CONCLUSION

Applicant respectfully submits that all of the claims pending in the application now are in condition for allowance. Reconsideration of this application in view of the foregoing amendments and remarks respectfully is requested.

The Examiner is invited to call Applicant's undersigned attorney if doing so would expedite prosecution.

The Commissioner is authorized to charge any fee which may be required in connection with this Amendment to deposit account No. 15-0665.

Respectfully submitted,

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